

REMARKS

After entry of the above amendments, the claims pending in the subject application are 1-2, 4-13, and 16-19. Reconsideration of this application based on the Amendments and Remarks presented herein is respectfully requested.

35 U.S.C. §112 REJECTIONS

Claims 1-19 were rejected under 35 U.S.C. §112, second paragraph.

The terms "thickener" and "binder" were used in claim 1. These terms are known terms in the paper coating art. In Polymer Dispersions and Their Industrial Applications, Wiley-VCH, 2002, Edited by D. Urban and K. Takamura, Chapter 4, Applications in the Paper Industry, J. Schmidt-Thümmes et al., pp. 75-101, the term "thickener" is defined and used at pp. 87-90, and the term "binder" is defined and used at pp. 90-97. Because these terms are terms recognized by one of ordinary skill in the art, it is respectfully submitted that these terms are not indefinite.

The term "dye" was used in claim 1, and the term "filler" was used in claims 10-11. It is known that some materials can be both a pigment/dye and a filler. For example, in United States Patent No. 4,425,405, pigments are listed at column 2, lines 32-36, and fillers are listed at column 3, lines 51-62. Many of the listed materials can be used as a pigment and as a filler. Also, from www.m-real.com/v2/environment/b_q_&_a_production.asp, materials such as china clay and calcium carbonate can be used as filler or pigment. One of ordinary skill in the art of paper coating knows that a material may serve more than one function. The amount of the material can be selected by one of ordinary skill in the art to give desired properties in the paper coating. Because it is known that a given material may serve more than one function, it is respectfully submitted that the terms "dye" and "filler" are not indefinite.

In claim 11, the terms "anionic pigment dispersion" and "cationic pigment dispersion" were used. These terms refer to dispersions of pigments. The pigments can be anionic or cationic. It is known that pigments can be provided in a dispersion (see p.87 of Polymer

Dispersions and Their Industrial Applications). Because the terms are descriptive of what they are, it is respectfully submitted that these terms are not indefinite.

35 U.S.C. §102 REJECTIONS

Claims 1, 2, 5, 6, 9-11, and 17-19 were rejected under 35 U.S.C. §102(a and e) as being anticipated by United States Patent No. 6,335,395 to Sadasivan et al. Note, this application is a divisional application of 09/898,317, filed on July 3, 2001. Sadasivan '395 did not issue until January 1, 2002. This publication date is after the priority date for the present application. Therefore, the reference is not available under 35 U.S.C. §102(a).

The element from claim 15 has been added to claim 1. Because the element from claim 15 was not rejected by Sadasivan '395, it is respectfully submitted that claims 1, 2, 5, 6, 9-11, and 17-19 are not anticipated by United States Patent No. 6,335,395 to Sadasivan et al.

Claims 1, 2, 5, 10, 11, and 17-19 were rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,698,296 to Dotson et al.

The element from claim 15 has been added to claim 1. Because the element from claim 15 was not rejected by Dotson '296, it is respectfully submitted that claims 1, 2, 5, 10, 11, and 17-19 are not anticipated by United States Patent No. 5,698,296 to Dotson et al.

Claims 1, 2, 6, 7, 9, 10, 11, 13, and 14 were rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,209,515 to Dotson et al.

The element from claim 15 has been added to claim 1. Because the element from claim 15 was not rejected by Dotson '515, it is respectfully submitted that claims 1, 2, 6, 7, 9, 10, 11, 13, and 14 are not anticipated by United States Patent No. 5,209,515 to Dotson et al.

35 U.S.C. §103 REJECTIONS

Claims 1-6, 10-12, and 17-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,425,405 to Murakami et al. in view of United States Patent No. 5,698,296 to Dotson et al.

The element from claim 15 has been added to claim 1. Because the element from claim 15 was not rejected by Murakami '405 in view of Dotson '515, it is respectfully submitted that claims 1-6, 10-12, and 17-19 are patentable over United States Patent No. 4,425,405 to Murakami et al. in view of United States Patent No. 5,698,296 to Dotson et al.

Claims 1, 2, 4-12, and 17-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,024,071 to Fringeli in view of United States Patent No. 5,824,190 to Guerro.

The element from claim 15 has been added to claim 1. Because the element from claim 15 was not rejected by Fringeli '071 in view of Guerro '190, it is respectfully submitted that claims 1, 2, 4-12, and 17-19 are patentable over United States Patent No. 4,024,071 to Fringeli in view of United States Patent No. 5,824,190 to Guerro.

Claims 1, 2, 4-7, 10-12, and 14-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,024,071 to Fringeli in view of United States Patent No. 5,814,188 to Vinson et al.

The element from claim 3 has been added to claim 1. Because the element from claim 3 was not rejected by Fringeli '071 in view of Vinson '188, it is respectfully submitted that claims 1, 2, 4-7, 10-12, and 14-19 are patentable over United States Patent No. 4,024,071 to Fringeli in view of United States Patent No. 5,814,188 to Vinson et al.

In view of the amendments and remarks contained above, Applicants respectfully request reconsideration of the application, withdrawal of the 35 USC §102, §103, and §112 rejections, and request that a Formal Notice of Allowance be issued for claims 1-2, 4-13, and 16-19. Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

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Date: 21 July 2004